

REMARKS

This application has been carefully reviewed in light of the Office Action dated January 5, 2010 ("Office Action"). Claims 3 and 37-57 are pending in the application. For purposes of advancing prosecution only, Applicants amend Claims 3, 37, 44, and 50. In the Office Action, the Examiner rejects Claims 3 and 37-57. Applicants respectfully traverse the rejections and request reconsideration and allowance of all pending claims.

Claim Rejections - 35 U.S.C. § 102

Amended Claim 50 and Claims 51, 54, and 55 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 6,249,578 issued to Gilles, et al. ("*Gilles*"). Applicants respectfully traverse the rejections for at least several reasons, as discussed further below.

For example, amended Claim 50 recites:

A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps of providing self- supporting service consumers, the method comprising:

automatically consulting, using the service consumer, a service policy comprising one or more service policy rules associated with the service consumer to request service;

automatically determining from the service policy, one or more actions to be taken to respond to the request for service, the one or more actions related to servicing the service consumer;

automatically initiating the one or more actions; and

automatically invoking one or more service provider tools to perform the one or more actions in response to the request for service, wherein:

allowing the service consumer to automatically consult the service policy comprises:

receiving the request for service from the service consumer independent of a user-initiated request for service;
and

comparing the request for service with the service policy.

At the outset, Applicants respectfully note that, for a rejection under 35 U.S.C. § 102 to be proper, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim," and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re*

Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added). *Gilles* fails to recite, expressly or inherently, every element of Claim 50 in as complete detail and as arranged by Claim 50.

As one example, *Gilles* fails to recite, expressly or inherently, “automatically consulting, using the service consumer, a service policy comprising one or more service policy rules associated with the service consumer to request service.” In addressing this element of Claim 50, the Office Action relies on *Gilles*, col. 2, ll. 53-67 and col. 14, ll. 2-21. Office Action, p. 3. However, the cited portions fail to disclose the claimed element in as complete detail and as arranged as Claim 50, as previously explained in a Response to Office Action filed September 29, 2009. In response to this argument, the Office Action asserts that “*Gilles* clearly discloses a ‘service policy’ or business rules/business policy such as determining whether the telecommunications customer is authorized for electronically exchanging information and determining whether the requested telecommunications service is available.” Office Action, p. 10. Even assuming the Office Action’s assertion were correct, neither the Examiner’s assertion nor the cited portion of *Gilles* discloses “automatically consulting, using the service consumer, a service policy . . .” as recited in Claim 50 (emphasis added). In particular, the Office Action fails to point to any portion of *Gilles* as allegedly disclosing “automatically consulting, using the service consumer, as service policy comprising one or more service policy rules associated with the service consumer to request service,” as recited in Claim 50 (emphasis added). As a result, *Gilles* fails to recite, expressly or inherently, “automatically consulting, using the service consumer, a service policy comprising one or more service policy rules associated with the service consumer to request service,” in as complete detail and as arranged as Claim 50.

Amended Claim 50 is therefore allowable for at least these reasons. Claims 51, 54 and 55 include all limitations of amended Claim 50, and are therefore allowable for at least the reasons discussed with respect to amended Claim 50. Accordingly, Applicants respectfully request reconsideration and allowance of amended Claim 50 and its dependent claims.

Claim Rejections - 35 U.S.C. § 103

Amended Claims 3, 37 and 44 and Claims 38-33, 45-49, 52-53, and 56-57 are rejected under 35 U.S.C. § 103(a) as being anticipated by *Gilles* in view of U.S. Patent Number

6,357,017 issued to Bereiter, et al. (“*Bereiter*”). Applicants respectfully traverse the rejections for several reasons, as discussed further below.

For example, the proposed *Gilles-Bereiter* combination fails to disclose every element of amended Claim 3. Amended Claim 3 recites:

A method of providing self-supporting service consumers, comprising:
detecting, with a service consumer, a fault that has occurred in the service consumer;
automatically consulting, using the service consumer, a service policy comprising one or more service policy rules associated with the service consumer to request a solution for the detected fault that occurred in the service consumer;
automatically determining from the service policy, one or more actions to be taken to respond to the request, the one or more actions related to providing the solution to the detected fault;
automatically initiating the one or more actions;
automatically invoking one or more service provider tools to perform the one or more actions in response to the request; and
communicating one or more service events that occurred as a result of the automatically initiating one or more actions and the automatically invoking one or more service provider tools wherein the communicating includes logging the one or more service events.

I. “detecting, with a service consumer, a fault that has occurred in the service consumer”

As one example, the proposed *Gilles-Bereiter* combination fails to disclose “detecting, with a service consumer, a fault that has occurred in the service consumer.” In addressing this element of amended Claim 3, the Examiner asserts that “both *Gilles* and *Bereiter* teach detecting, with a service consumer (such as caller, customer, or person), a need for service (such as fixing a fault, see *Bereiter*: abstract) that has occurred in the service consumer (customer’s computer).” Office Action, p. 11. Applicants respectfully note that this assertion improperly paraphrases the language of Applicants’ claim, which recites “detecting, with a service consumer, a fault that has occurred in the service consumer,” (emphasis added) in describing the alleged teachings of both *Gilles* and *Bereiter*. Applicants respectfully note that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Thus, it is improper to paraphrase elements or

omit claim terms for purposes of comparing the language of a claim to the teachings of cited art.

The Office Action further asserts that “[i]n order for a customer to request a service such as service for fixing a problem or fault in his/her computer, the customer must first detect an error, fault, or a need for service.” Office Action, p. 11. To the extent the Office Action is asserting that this element is inherently disclosed by *Bereiter* or *Gilles*, Applicants respectfully disagree. Applicants respectfully remind the examiner that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” M.P.E.P. § 2112 (emphasis added). Moreover, “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (emphasis added). Thus, the Examiner’s assertion that “[i]n order for a customer to request a service such as service for fixing a problem or fault in his/her computer, the customer must first detect an error, fault, or a need for service” fails to meet the standard that the subject matter be “necessarily present” as set forth above. Thus, the Office Action improperly paraphrases the language of amended Claim 3, and fails to provide a basis to support the determination that the elements of amended Claim 3 are necessarily present in the teachings of *Gilles* and/or *Bereiter*. As a result, the proposed *Gilles-Bereiter* combination fails to disclose every element of amended Claim 3. Amended Claim 3 is therefore allowable for at least these reasons.

Moreover, even if the Office Action’s recitation of Applicants’ claim language were correct, the cited portions of *Gilles* and *Bereiter* nevertheless fail to disclose “detecting, with a service consumer, a fault that has occurred in the service consumer.” The Office Action relies on *Gilles*, col. 2, ll. 53-67; col. 14, ll. 2-21 in addressing this element of amended Claim 3 and additionally asserts that *Bereiter*, Abstract discloses “fixing a fault.” Office Action, pp. 4, 10. As Applicants discussed above, a rejection based on any alleged inherent teachings of *Gilles* or *Bereiter* is improper with respect to this element. Thus, even if *Bereiter* discloses “fixing a fault” (a point which Applicants do not concede), *Bereiter* nevertheless fails to disclose “detecting, with a service consumer, a fault that has occurred in the service consumer.” In particular, the cited portion of *Bereiter* merely discloses “generat[ing] a data set indicative of a current operating state of the client machine” and “forward[ing] [the data set] from the client machine to the server for analysis.” *Bereiter*, Abstract. Thus, *Bereiter*

fails to disclose “detecting, with a service consumer, a fault that has occurred in the service consumer,” as recited in amended Claim 3 (emphasis added).

With respect to the Office Action’s reliance on *Gilles* in addressing this element, the cited portion of *Gilles* merely discloses “a real-time, interactive interface for telecommunications resellers to increase accuracy and reduce turn-around time.” *Gilles* col. 2, ll. 57-59. Additionally, the cited portion discloses “electronically receiving a request in a predefined format to establish an interactive session with a telecommunications customer [and] determining whether the telecommunications customer is authorized for electronically exchanging information” *Id.* col. 14, ll. 22-27. Thus, nothing in *Gilles* discloses or even suggests “detecting, with a service consumer, a fault that has occurred in the service consumer” (emphasis added). As a result, neither *Gilles* nor *Bereiter* discloses “detecting, with a service consumer, a fault that has occurred in the service consumer.” Amended Claim 3 is therefore allowable for at least these additional reasons.

II. “automatically consulting, using the service consumer, a service policy comprising one or more service policy rules associated with the service consumer to request a solution for the detected fault that occurred in the service consumer.”

The proposed *Gilles-Bereiter* combination fails to disclose this element of amended Claim 3. In addressing this element, the Office Action relies on *Gilles*, col. 2, ll. 53-67; col. 14, ll. 2-21. As discussed above with respect to an analogous element of Claim 50, *Gilles* fails to disclose this element of amended Claim 3. *Bereiter* fails to remedy the deficiencies in *Gilles*. To the extent the Examiner is relying on *Bereiter*, Abstract, in addressing the “detecting, with a service consumer, a fault that has occurred in the service consumer” element of amended Claim 3, *see* Office Action, p. 10, Applicants respectfully note that this proposed mapping fails to disclose the “allowing a service consumer to automatically consult a service policy” element amended Claim 3. According to *Bereiter*, “the data gathering process is repeated at the client machine, iteratively, until given information is available to a user of the client machine to correct the given technical problem.” *Bereiter*, Abstract. Even assuming the cited portion of *Bereiter* discloses the “detecting, with a service consumer, a fault” element of amended Claim 3 (a point which Applicants do not concede), the proposed mapping fails to disclose the “automatically consulting, using the service consumer,

a service policy . . . to request a solution for the detected fault that occurred in the service consumer” element of amended Claim 3. The Office Action alleges that the claimed “service policy” equates to a “business policy such as determining whether the telecommunications customer is authorized for electronically exchanging information and determining whether the requested telecommunications service is available” allegedly disclosed by *Gilles*. Office Action, p. 10. To the extent the cited portions of *Gilles* disclose “allowing the service consumer to automatically consult a service policy comprising one or more service policy rules associated with the service consumer to request a solution” (a point which Applicants do not concede), they nevertheless fail to disclose “allowing the service consumer to automatically consult a service policy . . . to request a solution” for the “given technical problem” as described in *Bereiter*, Abstract (emphasis added). Thus, the mere fact that *Gilles* discloses “determining whether the telecommunications customer is authorized” does not mean that *Gilles* discloses “allowing the service consumer to automatically consult a service policy comprising one or more service policy rules associated with the service consumer to request a solution for the detected fault that occurred in the service consumer” (i.e., the “given technical problem” disclosed in *Bereiter*). Moreover, as discussed above with respect to an analogous element of Claim 50, neither *Gilles* nor *Bereiter* discloses any manner of “automatically consulting, using the service consumer, a service policy . . .,” as required by amended Claim 3 (emphasis added). As a result, neither *Gilles* nor *Bereiter* disclose this element of amended Claim 3.

Accordingly, the proposed *Gilles-Bereiter* combination fails to teach, suggest, or disclose every element of amended Claim 3 for at least these reasons. Amended Claim 3 is therefore allowable for at least these reasons. Although differing in scope, Claims 37 and 44 include elements that, for reasons analogous to those discussed with respect to amended Claim 3, are not taught, suggested, or disclosed by the proposed *Gilles-Bereiter* combination. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 3, 37, and 44, and their respective dependent claims.

CONCLUSION


Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Christa Brown-Sanford, Attorney for Applicants, at the Examiner's convenience at (214) 953-6824.

Applicants believe that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Christa Brown-Sanford', is written over the printed name.

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